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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,495	01/05/2005	Fulvio Costa	033965.005	9871
25461	7590	12/31/2009	EXAMINER	
SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592				EMPIE, NATHAN H
ART UNIT		PAPER NUMBER		
1792				
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12/31/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/520,495	COSTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NATHAN H. EMPIE	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 November 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 21,24-27,29-34,36 and 38-40 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 21,24-27,29-34,36 and 38-40 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 24-27, 29-34, 36, and 38 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (Surface Modified SiO<sub>2</sub> Xerogel films from HMDS / Acetone for Intermetal Dielectrics, paper from 2000 International Microprocesses and Nanotechnology Conference, 11-13 July 2000; hereafter Kim) in view of Minami et al (US 2002/0160153 A1; hereafter Minami).

Claims 21, 24, 25, and 36: Kim teaches a process for the preparation and deposition of a vitreous film (SiO<sub>2</sub> xerogel film) on a substrate (such as silicon) (pg 218-219) comprising:

Preparing a solution in an aprotic solvent (acetone) of at least one alkoxide such as tetraethylorthosilicate (TEOS) (see, for example, pg 218, last paragraph)

Adding a catalyst to the solution (catalyst / such as HCl) (see, for example, pg 218, last paragraph)

Hydrolyzing the solution in the presence of the catalyst (HCl) in a hydrolysis reaction by addition of water to maintain a molar ratio of H<sub>2</sub>O /Me between 0.5 and 5 to obtain a clear (transparent) hydrolysis reaction product (see, for example, pg 218, last

paragraph, wherein the molar ratio of added H<sub>2</sub>O / Me (Si) is taught to be controlled at 2.5);

Depositing the hydrolysis reaction product in the form of a sol on the substrate (“this sol was spun on a p-type Si (100) substrate” (see, for example, pg 218, last paragraph)).

Kim further teaches wherein shrinkage, cracking, and collapse of structure of the sol-gel coating are considerations that can be deleterious to film performance so they should be addressed (see, for example, pg 218 paragraphs 1-3), Kim further teaches a hydrolysis process which would inherently produce an alcohol byproduct (see, for example, pg 218, paragraphs 1-3), but Kim does not explicitly teach the removal of the alcohol byproduct formed by the hydrolysis process. Minami teaches a method of forming a sol-gel derived film by a hydrolysis process involving a metal alkoxide in a solvent (see, for example, [0008]-[0023]). Minami further teaches that shrinkage and cracking of the resulting film can be prevented by partial and controlled desolvantization (evaporating the alcohol and water which are the products from the reaction of the sol-gel material, see, for example, [0041]). Minami further teaches removing the alcohol formed during the hydrolysis reaction is performed under reduced pressure (see, for example, 0041]). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a step of evaporating alcohol byproduct from the sol under reduced pressure, as taught by Minami, into the method of Kim as it help to reduce shrinkage and cracking in the final coating.

Claim 26: Kim further teaches wherein the solution of the alkoxide in aprotic solvent possesses a TEOS : Acetone molar ratio is 1:4 (see, for example, pg 218, last paragraph), which yields an approximate weight % of the alkoxide in the solvent of ~57% (FW TEOS ~208.32g/mol, FW acetone~58.08)

Claim 27: Kim further teaches wherein hydrolyzing of the alkoxide is accomplished by adding a controlled quantity of water (hydrolysis process for sol is preferably contains 2.5 mol of water, (see, for example, pg 218, last paragraph)).

Claims 29 – 30: Kim further teaches wherein the molar ratio of H<sub>2</sub>O / Me (Si) is 2.5 (see, for example, pg 218, last paragraph);

Claims 31 – 33: Kim further teaches where hydrolyzing of the alkoxide is accomplished in the presence of an acid catalyst selected from the group consisting of mineral and organic acids with Ka of 0.1 to 3, further an aqueous solution of HCl, (see, for example, pg 218, last paragraph), wherein a molar ratio of alkoxide / acid is 1/0.018 (see, for example, pg 218, last paragraph).

Claim 34: Kim further teaches wherein a molar ratio of alkoxide / acid is 1/0.018 (described in the rejection above), and Kim additionally teaches that by varying the catalyst concentration will influence on the transparency of sol and gelling time (see, for example, pg 218, last paragraph). Kim does not explicitly teach that the molar ratio of alkoxide to acid is preferably from 1/0.1 to 1/0.01, but it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated such a ratio within such a claimed range since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges

involves only routine skill in the art. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Claims 38 – 39: Kim further teaches wherein the coating is deposited by spin coating (see, for example, pg 218, last paragraph).

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Minami as applied to claim 21 above, and further in view of Ravaine et al (US patent 4,923,950; hereafter Ravaine).

Claim 40: Kim in view of Minami teaches the method of claim 21 (described above), and Kim further teaches wherein it is known in the art to use dried  $\text{SiO}_2$  xerogel films for intermetal dielectrics (pg 218-219), but Kim is silent as to a specific drying temperature; therefore Kim in view of Minami does not explicitly teach a final drying at a temperature of 20 to 500°C. When a primary reference is silent as to a certain detail, one of ordinary skill would be motivated to consult a secondary reference which satisfies the deficiencies of the primary reference. Ravaine teaches a method of forming a sol-gel derived film by a hydrolysis process involving a silicon alkoxide in a solvent (see, for example, abstract, col 3 lines 26 – 50). Ravaine further teaches that to form a xerogel, all of the alcohols and water must be removed from the gel by drying at a temperature around 120°C (col 3 lines 44 – 50) . Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a temperature of around 120°C, as taught by Ravaine, as the drying temperature for the

dried xerogel in the process of Kim in view of Minami, as Kim was silent and such a temperature is taught to predictably dry the gel to form a xerogel.

***Response to Arguments***

Applicant's remaining arguments filed 11/10/09 directed to the claim rejections under 35 USC 103 over Kim / Minami / Ravaine have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually (i.e. "...the Kim article does not disclose or suggest the step of removing alcohol that is formed during the hydrolysis reaction...", "Ravaine does not describe the hydrolyzation of the alkoxide solution in an aprotic solvent, followed by the removal of the alcohol by product", pg 6-7 of remarks), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner asserts that Minami is relied upon for teaching the removal of alcohol.

In response to applicant's assertion that Minami "does not describe the importance of removal of the ethanol which is produced by the hydrolyzation of the alkoxides" (pg 6 of remarks filed 11/10/09), the examiner asserts that Minami teaches a method of forming a sol-gel derived film by a hydrolysis process involving a metal alkoxide in a solvent (see, for example, [0008]-[0023]), and has explicitly taught "it is preferable to evaporate the solvent and water contained in the solution and the alcohol

and water which are products from the dehydration and polycondensation reaction of the above sol-gel material"..."thereby the shrinkage of the formed film is suppressed as much as possible, whereby the occurrence of cracks on the film can be prevented and the cured film can be formed without the occurrence of air bubbles in the film"...(both passages from [0041]). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further in response to applicant's argument that there is no suggestion to combine the Kim and Minami references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a step of evaporating an alcohol byproduct from the sol, as taught by Minami, into the method of Kim (wherein an alcohol byproduct is produced by the hydrolysis process of Kim) as Minami has explicitly taught such a step would help to reduce shrinkage and cracking in the final sol-gel derived coating.

In regards to applicant's arguments directed to the rejection of claim 40, again the argued alcohol removal step has been taught by Minami, as described in the rejection above and in the preceding paragraphs.

As to the remaining dependent claims, they remain rejected as no separate arguments are provided.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN H. EMPIE whose telephone number is (571)270-1886. The examiner can normally be reached on M-F, 7:00- 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571) 272-1418. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H. E./  
Examiner, Art Unit 1792

/Michael Cleveland/  
Supervisory Patent Examiner, Art Unit 1792